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09/597,131	06/20/2000	Jeffry Jovan Philyaw	PHLY-25,357	6197

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EXAMINER

FISCHER, ANDREW J

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 04/23/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/597,131

Applicant(s)

Jeffrey Jovan Philyaw

Examiner

Andrew J. Fischer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Feb 23, 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☒ The proposed drawing correction filed on Feb 23, 2000 is: a) ☒ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 7 20) ☐ Other:

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DETAILED ACTION

Election/Restriction

1. This application contains claims directed to the following patentably distinct species of the claimed invention:

Species A: Represented by Figure 25; and

Species B: Represented by Figure 26.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claims are generic.

Applicant is advised that a response to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to

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be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

2. During a telephone conversation with John J. Arnot on or about December 17, 2001 a provisional election was made with traverse to prosecute the invention of Species A, claims 1-22.

Affirmation of this election must be made by applicant in replying to this Office action.

3. The Examiner notes that currently Invention I (claims 1-11) are not patentably distinct from Invention II (claims 12-22). A restriction between the Inventions at this time would therefore be improper. Applicant is reminded that should future amendments make the claims patentably distinct or if Applicant argues the claims *are* patentably distinct, a restriction between the two inventions may follow.

4. Additionally, the Examiner notes that species represented by figures 9, 10, 12, and 13 are currently not patentably distinct. A election of species between them at this time would therefore be improper. Applicant is reminded that should future amendments make the species patentably distinct or if Applicant argues the claims *are* patentably distinct, a restriction between the two inventions would most likely follow.

Acknowledgments

5. The preliminary amendment filed October 23, 2000 (Paper No. 3) is acknowledged. Accordingly, claims 1-22 remain pending.

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Information Disclosure Statement

6. The information disclosure statement filed October 23, 2000 (Paper No. 7) fails in part to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because date and place of publication is not provided on the PTO-1449 form. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1).

Drawings

7. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on February 23, 2000 (Paper No. 8) have been approved by the Examiner.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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9. Claims 3, 4, 16-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are replete with errors. Some examples follow.

a. Claims 3 and 4 fail to recite any additional method steps. While the claims need not recite all of the operating details, a method claim should at least recite a positive, active step.

Ex parte Erlich, 3 USPQ2d 1011, 1017 (B.P.A.I. 1987) (citations omitted).

b. In claim 16, the phrase "which is transferrable to a user to said user" is unclear.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States. . . .

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

(f) he did not himself invent the subject matter sought to be patented.

11. Claims 12-16, as understood by the Examiner, are rejected under 35 U.S.C. 102(e) as being anticipated by Ogasawara (U.S. 6,123,259). Ogasawara discloses the following: a UPC code (column 11, last paragraph); an extraction circuit (within scanner 15); a temporary buffer

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(inherent in any CPU); an identification device (device that identifies the product scanner); a retail processing system (inherent); ownership of the article is transferred after receiving encoded information (and payment); the scanner has a unique id (column 10, paragraph starting on line 25); the personal scanner is wireless (wireless to the main store server 50 and its database); the user has an account set up for them prior to receiving the scanner (inherent).

12. Claims 1-5 and 12-16, as understood by the Examiner, are alternatively rejected under 35 U.S.C. 102(e) as being clearly anticipated by Barnett (U.S. 6,343,276).

13. Claims 1-22 are alternatively rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter. The Examiner notes this is an alternative rejection only. Because this is a continuation-in-part ("CIP") of multiple applications where the sole current inventor is not the only inventor in the applications relied for priority under §120, the issue of inventorship will most likely arise if Applicant attempts to rely on his priority. This rejection will be withdrawn if priority under §120 is not needed or, for other appropriate reasons, the inventorship because moot.

14. Claims 1-11, as understood by the Examiner, are also rejected under 35 U.S.C. 102(e) as being anticipated by Ogasawara. It is the examiner's position that Ogasawara anticipates the claimed method because the method is inherently disclosed. The rationale for this inherency is that the prior art device, in its normal and usual operation, would necessarily perform the claimed method. See MPEP §2112.02.

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15. Functional recitation(s) using the word “for” (e.g. “for storing said encoded information” as recited in claim 12) have been given little patentable weight because they fail to add any structural limitations and are thereby regarded as intended use language. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. *In re Casey*, 152 USPQ 235 (CCPA 1967); *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

16. After careful review of the specification and prosecution history, the Examiner is unaware of any desire—either expressly or implicitly—by Applicant to be his own lexicographer and define a claim term to have a meaning other than its ordinary and accustom meaning. Therefore, the Examiner starts with the presumption that all claim limitations are given their ordinary and accustom meaning. See *Bell Atlantic Network Services Inc. v. Covad Communications Group Inc.*, 262 F.3d 1258, 1268, 59 USPQ2d 1865, 1870 (Fed. Cir. 2001) (“[T]here is a heavy presumption in favor of the ordinary meaning of claim language as understood by one of ordinary skill in the art.”). See also MPEP §2111.01 and *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).¹

¹ It is the Examiner’s position that “plain meaning” and “ordinary and accustom meaning” are synonymous. See e.g. *Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1342, 60 USPQ2d 1851, 1854 (Fed. Cir. 2001) (“[A]ll terms in a patent claim are to be given their plain, ordinary and accustomed meaning . . .”).

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However, if Applicant does desire any claim limitation to have a meaning other than its ordinary and accustomed meaning, the Examiner respectfully requests Applicant to expressly indicate the claim limitation at issue² and to show where in the specification or prosecution history the limitation is defined. Such definitions must be clearly stated in the specification or file history. *Bell Atlantic*, 262 F.3d at 1268, 59 USPQ2d at 1870, (“[I]n redefining the meaning of particular claim terms away from the ordinary meaning, the intrinsic evidence must ‘clearly set forth’ or ‘clearly redefine’ a claim term so as to put one reasonably skilled in the art on notice

² “In order to overcome this heavy presumption in favor of the ordinary meaning of claim language, it is clear that a party wishing to use statements in the written description to confine or otherwise affect a patent’s scope must, at the very least, point to a term or terms in the claim with which to draw in those statements.” *Johnson Worldwide Assocs. v. Zebco Corp.*, 175 F.3d 985, 989, 50 USPQ2d 1607, 1610 (Fed. Cir. 1999).

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that the patentee intended to so redefine the claim term”).³ The Examiner cautions that no new matter is allowed.

Failure by Applicant to address this issue in the manner set forth above or to be non-response to this issue entirely will be considered a desire by Applicant to, at least initially, give all claim limitations their ordinary and accustomed meaning. Applicant is reminded that even though we start with this presumption, any interpretation disclaimed during prosecution may further limit that claim element. See *Pall Corp. v. PTI Technologies Inc.*, 259 F.3d 1383, 59 USPQ2d 1763, 1769 (Fed. Cir. 2001).

³ See also *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582, 39 USPQ2d 1573, 1576 (Fed. Cir. 1996), (“[A] patentee may choose to be his own lexicographer and use terms in a manner other than their ordinary meaning, as long as the special definition of the term is *clearly stated* in the patent specification or file history. [Emphasis added.]”); *Multiform Desiccants Inc. v. Medzam Ltd.*, 133 F.3d 1473, 1477, 45 USPQ2d 1429, 1432 (Fed. Cir. 1998) (“Such special meaning, however, must be sufficiently clear in the specification that any departure from common usage would be so understood by a person of experience in the field of the invention.”). See also MPEP §2111.02, subsection titled “Applicant May Be Own Lexicographer” and MPEP §2173.05(a) titled “New Terminology.”

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Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claims 1-11 are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Ogasawara.⁴ It is the Examiner's principle position that the methods are anticipated because of the reasons stated above.

However, even if not anticipated, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Ogasawara to include the claimed method. Because the prior art discloses all the structure necessary to perform the claimed functions, one of ordinary skill in the art would find the claimed method to be obvious in view of the disclosed structure as disclosed in claims 12-22.

⁴ See MPEP §2112 expressly authorizing alternative 102/103 rejections when the question of inherency is present in the §102 rejection.

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Conclusion


19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure includes the following: Hudetz et. al. (U.S. 6,199,048); Sloane (U.S. 5,918,211); Rando et. al. (U.S. 5,874,722); Trotta, Jr. (U.S. 5,595,264); Dumont (U.S. 5,457,307); Gupta et. al. (U.S. 5,361,871); Johnsen (U.S. 5,250,789); and Bianco (U.S. 5,047,614).

20. All MPEP sections cited within are from the Manual of Patent Examining Procedure (MPEP) Eighth Edition, August 2001 unless expressly noted otherwise.

21. The Examiner notes the multitude of U.S. applications within this application's patent family and priority chain. If Applicant attempts to use an earlier filed application under §120, the Examiner respectfully requests Applicant to clearly state the appropriate U.S. effective filing date for each particular claim at issue and to provide evidence supporting that filing date.

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew J. Fischer whose telephone number is (703) 305-0292.


ANDREW J. FISCHER
PATENT EXAMINER
4/16/02

 4/18/02
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AJF
April 16, 2002